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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/396,530 09/15/99 ADDINGTON

R 99-1002

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QM22/0226

EXAMINER

PIERCE, W

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

02/26/01

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 9

Application Number: 09/396530
Filing Date: 9/15/99
Appellant(s): Addington et al.

Joel Rosenblatt
For Appellant

SUBSTITUTE EXAMINER'S ANSWER

MAILED
FEB 23 2001
GROUP 3700

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In response to the reply brief filed 2/08/01, which has been entered and considered, this Substitute Answer takes the place of the previous mailed Examiner's Answer on 01/03/01 which contained only a partial draft in error. The proper and completed Answer, taking into account appellants remarks made in his 2/08/01 Reply, follows.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. In appellant's Reply he takes issue with the rejection of claims 3 and 4. While appellant does not directly make arguments pertaining to the propriety of the final rejection, such appears to be the position of the Appellant. The Examiner submits that this issue is not one to be considered by the board. As set forth in 706.07[®] of the MPEP, this is purely a question of practice, wholly distinct from the tenability of the of the rejection. Such may not be advanced as a ground for appeal or made a basis of complaint before the Board. It is reviewable by petition under 37 CFR 1.181 (emphasis added). The Examiner's position and the rejection of these claims are treated in the Grounds for Rejection that follows in section (10) below.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is unclear.

No amendment after final has been filed.

Appellant makes the statement that, "No action is shown for the Final Rejection for amended claims 3 and 4" and then goes on to state (Brief, pg. 1, second to last ln.) that "claims 1-13 are canceled".

Contrary to appellants above noted statement, claims 3 and 4 are in fact pending and their treatment is set forth in section (10), the Grounds for Rejection, below.

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(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because Appellant's Summary is argumentative and is not limited to the structure of the claimed invention.

For example, in this summary appellant makes admissions to the "Knowledge of One Skilled in the Art" show that his invention is a method of using a finger pad protector which is well known in the prior art and comments on the examiner's previous rejections (bottom of pg.3). Here, Appellant makes admissions that it is well known in bowling that a ball is delivered down the alley by bowler having his thumb and two opposed fingers inserted in the ball in an underhand swinging motion with the thumb finger side of the ball leading in the back and downswing portion of the delivery. Such are not part of his invention. But, they are used to try and remedy the pending New Matter rejection. Further it is discussed that during the upswing the hand naturally will have a tendency to rotate so that the thumb reverses its position so that it is facing downward at the end of the delivery. It is further known to one skilled in the art of bowling and basic physical science that there are force interactions between the ball and fingers as the hand rotates during the delivery to impart spin on the ball. This is also referred to as hook, action or lift as noted by appellant on pg. 2 ln. 10 of Brief. Known in bowling are the use of finger protectors to relief the pressures caused by the force of the ball on the fingers during the delivery. These protectors can improve grip, protect or support the fingers for a more comfortable and consistent release. Hence, the main position of the Examiner is that Appellant's finger protector functions inherently as any other finger protector known in the art to improve grip, support the fingers and transmit the

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forces between the fingers and the ball during the delivery of the ball down the alley. However, Appellant has drafted the claims in functional terms to describe the forces between the finger pad of the bowler, finger shield and the ball. Since no previous patent has ever set forth claims in this context, Appellant has taken the position that his invention is patentable. However, appellant is not claiming anything new. His delivery is the same and his use of his protector is conventional. Appellant goes on to admit on pg. 3 that the forces involved in the delivery of a bowling ball and rotation of the hand to impart spin are old and well known based on "Newton's commonly known second law".

Hence, his claims are inherently shown by any finger protector known in the art since they are all capable experiencing the forces and performing the steps claimed by the appellant.

Appellant's Reply brief filed 2/8/01, argues that his summary is a "concise explanation" and followed "the accepted meaning of Summary" defined in Webster's New Collegiate Dictionary. This issue is considered moot since Examiner has not imposed any requirement on the appellant to correct the Brief. Examiner's remarks to Appellant's summary were intended to clarify Appellant's argumentative style to facilitate the understanding of the invention "defined in the claims involved in the appeal" (37 CFR 1.192(5)) since his summary only serves to cloud the

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real issues of patentability, which are the real concern of the Board. As such, the remaining remarks on pg. 2 and 3 of the Reply will be noted without comment.

(6) Issues

The appellant's statement of the issues in the brief is correct with respect to issues 1 and 3. The drawing requirements of 2 is not an appealable issue and issue 4 is merely an argument made in attempts to overcome the rejection of the claim made under 102(b) (which is issue 3).

As such, two issue in this Appeal are whether the claims are adequately supported by the specification under 35 USC 112, first paragraph and whether or not they are anticipated under 102(b) by Marinese.

In appellant's reply, he continues to argue issue 4 stating that it was created by "Examiner's unlawful rejection of Appellant's Declarations". While appellants content in this section is improper¹, a brief response is necessary to set forth examiner's position. First it is clear that there was no "rejection" of the Appellant's Declarations. The declarations were considered and failed to distinguish over the applied art upon secondary consideration. Appellant subsequently begins to inappropriately argue about an APA Standard. Appellant's

¹Issues presented in the Brief should "not include any argument concerning the merits of those issues".

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misapplication of law and the examiner's position there on is treated in (11) Response to Argument below. Secondly, as set forth in MPEP 715.08, review on the merits of an affidavit or declaration by the Board is only for those made under 37 CFR 1.131. Appellant's declarations are made under 37 CFR 1.132 wherein there treatment may not be advance to the Board as a grounds for Appeal. Hence, no further comment with respect to pg. 5 -9 of the Reply are deemed necessary since they are will be shown to be misapplied and without merit in the section below.

(7) *Grouping of Claims*

The rejection of claims 3, 4 and 14-30 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct. The Board is alerted that Appellant has not presented the claims in sequence. Claims 3 and 4 are embedded in between claims 14-30.

(9) *Prior Art of Record*

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The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

3,046,561

Marinese et al

7-1962

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 14-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification.

The specification fails to discuss the steps as set forth in claims 14-30. This is a new matter rejection in that the specification fails to provide support for the claims as they are now amended.

2. Claims 3, 4 and 14-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Marinese et al.

As to claim 14, paragraphs a-c are shown in Marinese by his finger pad shield 1 in contact with a finger pad of a bowlers finger at 7b. The finger pad 1 shield has a first and second surface at 7b and 3 respectively as shown in his fig. 1. Fig. 1 shows inserting the finger pad into a finger hole of a bowling ball. The apparatus of Marinese transmits the forces applied by the bowlers

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fingers to the finger pad and then to the bowling ball to control the release and the lift placed on the ball as called for in steps d-f. While these “applying a first force”, “producing a second force” and how these forces interact with the finger pad and the bowling ball are not specifically disclosed, it is noted that, in method claims, the prior art anticipates a claimed invention if the device carries out the method during normal operation . (See MPEP 2112.02). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. While the discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using. In re Huck , 114 USPQ 161, 163 (CCPA 1957). Such is not the case here since the apparatus of Marinese and the instant invention are being use to transmit forces from a bowlers hand to a bowling ball which is old and well known.

Steps d-f of claim 14 are old to the use of all finger supports. Such a position of the Examiner that these steps are old is admitted by Appellant at the bottom of pg. 13 through the bottom of pg. 15 of his Brief. Clearly, Appellant is merely reciting the known forces that interact between the finger, protector and the ball during the delivery of a bowling ball.

As to claim 15 a bowler is considered to always exert a “maximum natural force” when delivering a ball. The forces recited to be involved are admittedly well known in the art at the bottom of pg. 16 of the Brief.

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As to claim 3, Marinese is considered to be “made of rigidly deflectable material” capable of “holding said finger pad shield stable” and “transferring a force”. As such the limitations of claim 3 are considered met. Further such limitation are present in the prior art as admitted in the middle of pg. 17 of the Brief.

Distributing the force over the widest area of the contact area as recited in claim 16 is know in Marinese and old in the art. Top of pg. 19 of the Brief admits that nothing new in the art is being claimed.

The step of “reducing said pressure substantially within said contact area” in claim 17 is rudimentary to finger supports such as Marinese and admitted as known in the prior art at the top of pg. 20 of the Brief.

Distributing the second force substantially uniform as called for in claim 18 is inherent in Marinese and old in the prior art as admitted on the top of pg. 21 of Brief.

Reducing the contact pressure as in claim 19 is inherent in Marinese and old in the prior art as admitted on the top of pg. 22.

Claim 20 is inherent in Marinese and old in the prior art as admitted on the top of pg. 23.

Claims 21-30 are rejected for the reasons set forth above with respect to claims 3 and 14-20 above.

On pg. 10 of Appellant’s Reply he states that “lift” is not mentioned anywhere in Marinese. While this is true, the term lift as it pertains to the delivery of a bowling ball is old and well known in the art. Appellant agrees with the Examiners position and admits that such is old

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at the bottom of pg. 13 of his Brief. A reference is to be considered not only for what is expressly states, but for what it would reasonably have suggested to one of ordinary skill in the art. (In re DeLisle, 56 CCPA 1319, 406 F.2d 1386, 867 OG 722, 160 USPQ 806). Further in determining the question of obviousness, it is not only the express teachings of the references which are to be considered but what they would collectively have suggested to one of ordinary skill in the art. (See In re Simon, 59 CCPA 1140, 461 F.2d 1387). In the instant case, one skilled in the art of bowling and viewing Marinese would have been familiar with the delivery of a bowling ball down the alley and the forces involved. This is admitted by the Appellant in his Brief as not new. As such, the instant obviousness rejection is considered well founded. Pgs. 11-14 of Appellants Reply are noted without additional comment since they merely restate Appellants position set forth in the Brief.

(11) Response to Argument

With Respect to Appellant's Reaching Application of The Administrative Procedure Act Standard.

Appellant cites the Administrative Procedure Act Standard which he relies on heavily throughout his arguments. However, the APA is not dispositive and its application inappropriate. The basic purposes of the Administrative Procedure Act may be said to have four basic purposes as follows: 1. To require agencies to keep the public currently informed of their organization,

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procedures and rules 2.To provide for public participation in the rule making process. 3.To prescribe uniform standards for the conduct of formal rule making and adjudicatory proceedings , i.e., proceedings which are required by statute to be made on the record after opportunity for an agency hearing. 4.To restate the law of judicial review. Such has nothing to do with the examination of patents and Appellant should not cloud the prosecution by referring to it. Appellant, as a patent professional, should be aware by now that the examination of patents is conducted in accordance with the Manual of Patent Examining Procedure. The examination of applications is covered in chapter 700. If applicant is not familiar with the MPEP, can find a copy on the PTO web site at USPTO.gov. Hence, all of Appellant's remarks will be responded to in accordance with the MPEP and not the APA.

Appellant should note that The legislative history of the APA suggested to the Federal Circuit that "Congress drafted the APA to apply to agencies generally, but that because of existing common law standards and the availability of trial de novo pursuant to §4915 of the Revised Statutes, the predecessor of 35 USC §145, Congress did not intend the APA to alter the review of substantive Patent Office decisions.". See 5 USC §559 (emphasis added).

As a result, the Federal Circuit concluded: From this background, we construe §559 as freeing Patent and Trademark Office patentability decisions from judicial review under standards enumerated by §§706(2)(A) (arbitrary or capricious standard applied to informal agency proceedings) and 706(2)(E) (substantial evidence standard applied to formal agency proceeding), to the extent that a statutory or common law standard was a more searching standard and hence

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an additional requirement recognized prior to 1947 that has not since been statutorily modified. Thus, the portion of §§559 stating that the judicial review provisions of the Act were not meant to "limit or repeal additional requirements ... recognized by law" is best understood as preserving those standards of judicial review that had evolved as a matter of common law, rather than compelling that all such standards of review be displaced by the new statute. This construction preserves the benefits derived from the symbiotic relationship between judicially constructed common law and congressionally fashioned statutory law in the area of judicial review.

As to *Dickenson v. Zurko*, the case has done nothing to change the way patents are examined as set forth in the Manual for Patent Examining Procedure. The case deals only with limiting the power of the U.S. Court of Appeals for the Federal Circuit (CAFC) to "second guess" the USPTO in making patentability judgements, including those concerning obviousness. The *Zurko* decision involved a disputed non-obviousness decision by the CAFC and as a result of the decision in the case, in the future, the CAFC will be unable to substitute its judgement for that of the USPTO unless the CAFC determines that the USPTO abused its discretion or acted arbitrarily or capriciously in reaching its conclusion of unpatentability.

Appellant's continued reference to the APA and the "lawfulness" of the examiner's grounds for rejection only serve to cloud the issues. As such, applicant's references thereto will not be further addressed and will not be entertained when referred to throughout the Brief and the Reply.

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ARGUMENT NO. 1

- I. Pertains to the APA and is considered moot.
- II. Appellant cites several sections of the MPEP pertaining to the “written description requirement”. These are noted. However, no there existed no objection or rejection of the “written description” and this section is also considered moot.
- III. Appellant states, in short, that his specification describes “distributing the force of the bowling ball over the bowler’s finger pad”. This is not disputed. However, that is the only extend of the description and it fails to support claims 14-30.

As to claim 14, support for paragraphs a-c is not disputed. However, Appellant acknowledges his failure to provide support for paragraph d and attempts to compensate for a lacking in the specification “incorporating” the “Knowledge of One Skilled in the Art. However, the Examiner submits that this is insufficient since, “applying a first force...in a first direction against said first surface...and producing a second force in a second direction...receiving said second force...distributing said second force”, is clearly not disclosed, as admitted by Appellant and one should not have to infer the actual content of the specification.

Appellant subsequently and sequentially recites the remaining claims and make the statement of “what one skilled in the art knew” for each of them. For the reasons set forth above, such a position fails to compensate for the lack of support in the specification.

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IV.

A. No rejection as to enablement is set forth and this issue is considered superfluous and moot.

B. Sets forth a restatement of Examiner's position and no response is deemed necessary.

C. Again Appellant's comments with respect to the APA are not entertained.

Appellant is mistaken that "Examiner's grounds for rejection, is for the sole given reason, as 'first' and 'second'". Pg. 4, ln. 6 of the Final Office Action merely uses this for an "example" to support the rejection since specifically listing all instances in the claims that supported a new matter rejection would be time consuming and burdensome. This example shows that nowhere in the specification is discussed a "first" and "second force" or "direction".

Appellant contends that he has the right to use the terms not contrary to their accepted meaning. Such is not disputed. But, such is also not the grounds for rejection. Nowhere in the specification is the interaction of these forces and the directions they are applied discussed and relying on what is known in the prior art does not overcome this grounds for rejection.

Next Appellant goes on to suggest removing the terms "first" and "second" from the claim when reading it. Such claim interpretation is irrational and fails to overcome the grounds for rejection. Examination of the claims is made on what is recited and not on how the claim can be interpreted if certain words were removed.

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ARGUMENT NO. 2

As set forth above in the *Issues*, the drawing requirements is not an appealable issue. In line with MPEP 608.02(e), the Examiner determines the completeness of drawings.

While Appellant goes off and argues in confusion on 35 USC 113 and 35 USC 112, clearly neither applies. 35 U.S.C. 113 deals with the situation wherein the drawing is not necessary for the understanding of the invention, but the subject matter admits of illustration by a drawing and the applicant has not furnished a drawing. 35 USC 112 deals with clarity of the claims. The basis for the examiners requirement is clear, § 1.83(a) Content of drawing. Clearly stated there in “(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).”

Applicant’s position that Examiner’s requirement “leads to a ridiculous result” is reaching. Drawings are used to facilitate the understanding of the claimed invention and are useful to allow one to quickly ascertain the claimed invention. Requiring the claimed invention to be clear from the drawings is not a ridiculous result and is the intent of Rule 1.83(a) which the Examiner has determined that Appellant is not in compliance therewith.

Finally, while this is not an issue for appeal, no further comment is deemed necessary.

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ARGUMENT NO. 3

I. Appellant refers to the prosecution history in general in attempts to overcome the grounds for rejection. Examiner's position is set forth above in section (10), the Grounds for Rejection.

II. A. Noted with no response deemed necessary.

B. In this section Appellant appears to be alleging that the Examiner has not met the burden of proof to show inherency. First, once the rejection was made by the Examiner, the burden was shifted to Appellant. Note MPEP 2183;

If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. In re Mulder , 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent. See also, In re Walter , 618 F.2d 758, 768, 205 USPQ 397, 407 - 08 (C.C.P.A. 1980) (a case treating 35 U.S.C. 112, sixth paragraph, in the context of a determination of statutory subject matter and noting "If the functionally - defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions . . . the burden must be placed on the applicant to demonstrate that the claims are truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions"); In re Swinehart , 439 F.2d 210, 212 - 13, 169 USPQ 226, 229 (C.C.P.A. 1971) (a case in which the CCPA treated as improper a rejection under 35 U.S.C. 112, second paragraph, of functional language, but noted that "where the Patent Office has reason to believe that a functional limitation asserted to be critical for

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establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on"); and In re Fitzgerald , 619 F.2d 67, 205 USPQ 594 (CCPA 1980) (a case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103).

Appellant has not shown that prior art element does not perform the functions specified in the claims. While he did make attempts to do so with the Addington Declaration, such was insufficient since it was subjective in its interpretation and failed to set forth facts. In addition, on pgs. 13-23 of his Brief specifically sets forth that these functions in the claims are old and well known in the art. As such the application of Marinese is deemed proper and should be affirmed.

C. This section pertains to the APA and will not be addressed.

III.

A) Restates the limitations in the claims and amount to a general allegation of patentability. No further comment is made by the Examiner to this section.

B) Appellant makes the general allegation that the grounds for rejection is deficient yet makes no remarks how the limitations of the claims avoids the applied art. No further comment is deemed necessary.

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C) Appellant states, by example, that Examiner does not show things such as “use of the bowler’s fingers to control release and lift”. While this is so rudimentary to bowling to even entertain as an issue, the Examiner does point out in fig. 1 of Marinese at the bottom of pg. 2 of the Final Rejection, and states at the top of pg. 3 that, “Marinese transmits forces applied by the bowlers fingers...to control the release and the lift place(d) on the ball”. The appellant’s position that this is “a conclusion” is true. That is the job of the Examiner to form conclusions pertaining to patentability. To say that there is no fact to support it is plain wrong and argumentative.

Examiner must consider the art as a whole. When one places fingers in a bowling ball as shown in the fig. 1 of Marinese, the release of the ball down the alley is well known. Hence, it is clear that the Examiner’s position is well supported by the applied art and what is expected to be known by one of ordinary skill in the art.

D) Appellant argues that the Examiner has not rebutted “the fact based argument” of the Addington Declarations. As set forth in paragraph 6 of the Final Rejection, the Addington Declarations forms conclusions based on opinion and carries little weight in overcoming the grounds for rejection to show that Marinese does not possess the claimed limitations inherently. While these unsupported statements have been considered, they were not taken as fact and are still not.

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E) Examiner's position with respect to the rejection is set forth above in the Grounds for rejection. Appellant's comments with respect to the APA are ignored for the reasons set forth continually above.

F) Appellant takes the position that Marinese only discloses "grasping the ball". Examiner has meet the burden in the grounds of rejection by showing that the claims are anticipated by the prior art based on inherency and of knowledge expected of one of ordinary skill in the art. As repeated many times above, the delivery of a bowling ball down an alley is well known and needs not be reiterated by Marinese in order to understand how his invention is intended to be used and the forces involved. Pg. 13-21 of appellants Brief admit that such is old and well known and put the issue to rest.

G) Contrary to Appellant's position, Examiner's grounds for rejection 1) addresses each of the claims and sets forth the his position, 2) provides reasons and 3) is not incumbent to recognize the "substantial evidence" standard recited in the APA.

H) Examiner shows that the delivery and the forces involved claimed by Appellant are inherent in the delivery of a bowling ball which is old and well known to one skilled in the art. Upon making such a rejection, the burden was shifted to Appellant to show that inherency does not

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exist. Appellant has not risen to meet this burden. In fact, he agrees with the Examiner's position on pgs. 13-21 of his Brief that everything he is claiming is old and well known.

IV

This section applies the APA standard and is a moot issue deserving no further comment.

ARGUMENT NO. 4

This argument is misstated since the Examiner has never set forth a rejection with respect to the Addington Declaration. The Examiner's position was that, upon secondary consideration, they were insufficient to overcome the grounds for rejection.

I. Examiner's statement of the rejection is set forth above in the grounds for rejection.


II. The appropriateness of submitting declarations to rebut a prima facie case of obviousness is not disputed.

III. All of Dr. Addington's remarks were noted and well taken. However, they were subjective and based on opinion rather than fact. As such, they failed to overcome the grounds for rejection as being conclusionary based on opinion. Clearly such does little to overcome the pending grounds for rejection.

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CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

wp
February 20, 2001

